

Applicant: Herbert Wehler  
Application No.: 10/571,880

## **Remarks**

Claims 1 and 14 to 22 are pending in this application, and all have been rejected for the reasons discussed below.

## **Information Disclosure Statement**

Filed herewith is an Information Disclosure Statement that includes an English translation of an office action, pending claims, and the cited references from corresponding Chinese Patent Application No. 20040026747.9.

## **Amendments**

Claim 1 is amended to recite that the energy chain's first end is directly connected to the sliding door and that the energy guide chain includes a single curved region that adjusts to define two different radii of curvature when the door moves between the open and closed positions. Claim 22 includes similar amendments.

## **Claim Rejection Under 35 U.S.C. §102**

Claims 1, 14, 19 and 22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Suzuki*, U.S. Patent 6,787,702. Claims 1, 14, 15, and 19 to 22 are rejected under 35 U.S.C. §102(e) as being anticipated by *Kobayashi et al.*, U.S. Publication 2004/003543. To maintain a rejection under 35 U.S.C. §102(b), all of the elements of each claim must be disclosed in a single reference. The test for anticipation requires a strict, not substantial, identity of corresponding claim elements. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334-35, 2008 U.S. Appl. LEXIS 8404, 27-28 (Fed. Cir. 2008). Applicants respectfully submit that the amended claims are not anticipated and would not have been obvious to one of ordinary skill in the art.

*Suzuki* discloses an energy guide chain that is not directly connected to the sliding door. One end of its chain is connected to item 7, and the other end is not connected at all. Instead a

“slack absorbing device” contains the wires or wiring harness running through the chain and the chain is supported by the wires. (Item 24 in Figs. 1 to 3, 5, 6, 11, and 17 and item 24' in Figs. 7 and 8). A slack absorbing device would not be useful in the present invention because the energy guide chain in the present invention is joined to the door.

Furthermore, *Suzuki* discloses an energy guide chain having two curved regions. A first curved region 21 is shown in Fig. 1 when the sliding door is closed. This curved region at one end of the energy guide chain is seen adjacent to the fixing part 7. In the open position as shown in Fig. 2, the energy guide chain has a second curved region 20 that is spaced apart from the fixing part 7. The first region 21 that was curved is now straight.

In *Suzuki*, during the opening action of the sliding door, the energy guide chain must be moved from the position as shown in Fig. 1 into an elongated or straight position and then into the position as shown in Fig. 2. Consequently, the energy guide chain as described in *Suzuki* has two different regions for curving (c.f. col. 7, lines 38 to 59). This arrangement necessitates the slack absorbing device.

*Suzuki* discloses as an alternative solution of a tube instead of a chain, but the tube is not connected to the door either. The tube also has two curved regions. Figs. 1 and 11 show a sliding door in a closed position and Figs. 2 and 12 show the sliding door in an open position. In view of the configuration, it is clear that the energy guide chain tube moves from the position as shown in Figs. 1 or 11 into the Fig. 2 or 12. A tube is not as useful as a chain because it does not articulate during movement as much as an energy guide chain. For example, if the tube is pushed, the door will tend to move toward a closed position. Also, there are two different angles possible when a tube is used, and it may not move in the right direction when the door moves between the open and closed position.

*Kobayashi et al.* shows a similar construction of an energy guide chain, *i.e.* a guide chain with at least two separate regions of curvature. Further, *Kobayashi et al.* illustrates in Figs. 12, 1, and 2 that its energy guide chain has a constant radius of curvature. Thus, the recitations in independent claims 1 and 22 of an energy guide chain having a single curved region are not anticipated or rendered obvious by *Kobayashi et al.* because there is no strict correspondence of elements with the rejected claims.

### **Claim Rejection Under 35 U.S.C. §103**

Claims 16 to 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Suzuki* and *Kobayashi et al.* as applied to claims 1, 14, 19 and 22. Applicants respectfully submit that the claimed inventions would not have been obvious to a person skilled in the art.

### ***The Standard for Prima Facie Obviousness***

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skills in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, *the prior art reference must teach or suggest all the claim limitations. In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (Emphasis added). See M.P.E.P. §2143.

Obviousness is not to be read into an invention on the basis of the Applicant's own statements; that is, the prior art must be viewed without reading into that art Applicant's teachings. *In re Murray*, 268 F. 2d 226, 46 CCPA 905; *In re Sporck*, 301 F.2d 686, 49 CCPA 1039. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of Applicant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 395 F.2d 801, 55 CCPA 1198.

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### **Allowability of Claims 16 to 18**

For the reasons stated above, regarding how *Suzuki* and *Kobayashi et al.* do not anticipate the independent claims, they also do not render the claims obvious because they are lacking elements recited in claims 1 and 22. Specifically, the energy guide chain of *Suzuki* is only connected at one end. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). *See* M.P.E.P. §2143. Thus, no combination of the elements disclosed in these patents could have taught, motivated or suggested to a person skilled in the art to make the claimed invention.

### **Conclusion**

For the foregoing reasons, Applicant respectfully submits that the pending claims are allowable and request that this case be passed to issue.

Respectfully submitted,

  
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